

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/626,624	07/25/2003	Takayuki Kohchi	026350-087	9637
21839 75	90 10/11/2006		EXAMINER	
-	, INGERSOLL & ROOM	YU, GINA C		
POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
,			1617	
		•	DATE MAILED: 10/11/2000	6

Please find below and/or attached an Office communication concerning this application or proceeding.



•	Application No.	Applicant(s)					
	10/626,624	KOHCHI ET AL.					
Office Action Summary	Examiner	Art Unit					
	Gina C. Yu	1617					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute. Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	TE OF THIS COMMUNICATION (6(a). In no event, however, may a reply be tim (ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	J. lely filed the mailing date of this communication. O (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on 17 Ju	ly 2006.						
<u>_</u>	action is non-final.						
3) Since this application is in condition for allowan	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>19,20 and 25-29</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6)⊠ Claim(s) <u>19, 20, 25-29</u> is/are rejected.							
7) Claim(s) is/are objected to.	7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or election requirement.							
Application Papers							
9) The specification is objected to by the Examiner.							
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 							
er en							
Attachment(s)							
1) Notice of References Cited (PTO-892)	4) Interview Summary						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)	Paper No(s)/Mail Da 5) Notice of Informal P						
Paper No(s)/Mail Date 6) Other:							

Art Unit: 1617

DETAILED ACTION

Receipt is acknowledged of amendment filed on July 17, 2006. Claims 19, 20, 25-29 are pending. Claim rejection made under 35 U.S.C. 102 (b) in view of JP 9241637A (previously referred to as Okubo et al.), as indicated in the previous Office action dated January 17, 2006, is modified to address the newly added claims. The remaining rejections in the same Office action are withdrawn in view of the claim amendment made by applicants.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by (JP 9-241637-A, English Translation) ("'637").

Claims 19, 20, 25, and 26 recite a composition "consisting essentially of citrulline in an amount of 0.5 mM to 60 mM". The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics

Art Unit: 1617

actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

'637 discloses in Table 1 that 0.01-20 mM of citriulline provides antioxidant effect. See Translation, [0086]-[0097]; instant claims 19, 20, 28, and 29. The reference also discloses in paragraphs [0080]-[0084] that citrullin, along with epigallocatechin, is mixed and incorporated into pharmaceutical agents, food, and in cosmetics to improve the shelf-life of the products. See instant claims 25-27.

While '637 does not expressly mention a method of treating skin by applying the citrulline-containing composition as recited in claim 19, the claimed method is anticipated since the topical application of the prior art pharmaceutical or cosmetic composition is the inherent use of the product. Since the prior art teaches citrulline-containing cosmetic compositions, it is viewed that "active oxygen in the skin is scavenged by the citrulline" when the user applies the composition to the skin according to the intended use of the product.

Response to Arguments

Applicant's arguments filed on July 17, 2006 have been fully considered but they are not persuasive.

Applicants assert that the anticipation rejection over '637 is improper, indicating that the reference teaches citrulline as a weak antioxidant. However, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See <u>In re Susi</u>, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply

Art Unit: 1617

because it has been described as somewhat inferior to some other product for the same use." See In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In this case, the teaching in '637 that citrulline itself does not have a strong scavenger effect does not negate the disclosure that citrulline is an active oxygen radical scavenger. The antioxidant property of citrulline in the recited amount has been known in the art.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

Application/Control Number: 10/626,624 Page 5

Art Unit: 1617

The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina C. Yu Patent Examiner

> SREENI PADMANABHAN SUPERVISORY PATENT EXAMINER